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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/914,487 | 08/27/2001 | Shlomo Shkolnik | 174/02403 | 8039 |

44909 7590 10/31/2006

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EXAMINER

PROCTOR, JASON SCOTT

ART UNIT PAPER NUMBER

2123

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/914,487 | Applicant(s) SHKOLNIK, SHLOMO | |
| | Examiner Jason Proctor | Art Unit 2123 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-26,30-43,45-77 and 79-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-26,30-43,45-77 and 79-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 23-26, 28-43, and 45-85 were rejected in the Office Action of 20 April 2006. Applicants' response of 21 August 2006 has amended claims 23, 32, 40, 45, 50, 55, 59, 70-72, 75, 77, and 80-84; cancelled claims 28-29 and 78; and presented new claim 86.

Claims 23-26, 30-43, 45-77, and 79-86 are pending in this application.

Claims 23-26, 30-43, 45-77, and 79-86 are rejected.

Applicants' Remarks

The following remarks submitted on 21 August 2006 are considered relevant to the issues of claim scope and interpretation.

Claim 32 was additionally amended to require that each design tool stores sufficient information for carrying out a design task of a respective system. This requirement is inherent in the fact that the tools are design tools. (page 12)

Claim 32 was rejected for using the term "suitable for performing design tasks". Applicant amended the claim to use the term "computerized design tools", which are well known in the art and perform specific design tasks. The data required by these design tools in order to perform their tasks is well known in the art. (pages 14-15)

Claims 59, 74, and 83 were discussed in the telephonic interview. Applicant's agents have stated that the elements are all the elements of the vehicle including rivets. Applicant, however, amended claims 59 and 83 to state that the percentages relate to the elements of the vehicle described by the design tools. (page 15)

Claim Rejections - 35 USC § 101

The previous rejection of claims 72-74, 41-42, and 82-85 under 35 U.S.C. § 101 are withdrawn in response to Applicants' amendments of these claims.

35 U.S.C. § 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 45-52 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106(II)(A) states:

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Claim 45 recites "a method of labeling major elements of an aircraft" that results in "identifying the major elements in a database using the assigned codes". Claim 45 fails to produce a useful, concrete, and tangible result. A step of "identifying" fails to produce a useful, concrete, and tangible result.

2. Claims 50-52 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 50 recites "a method of referencing workers on an aircraft" that results in "identifying the workers in a database using the assigned codes." Claim 50 fails under the same analysis shown above for claim 45. Claim 50 fails to produce a useful, concrete, and tangible result.

In response to these rejections, Applicants argue primarily that:

While the Examiner cited MPEP 2106(II)(A), applicant respectfully submits that it seems the Examiner has failed to follow its teachings. This passage clearly states that the claims must produce a

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useful, concrete and tangible result, in order to "limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept or is simply a starting point for future investigation or research". None of the rejected claims is a mere idea or concept or simply a starting point.

Regarding the requirements of usefulness, applicant has explained in length in the application the usefulness of the methods of the invention which aid in designing vehicles.

Regarding tangibility, the guidelines of October 26, 2005, titled "Interim Guidelines for Examination of Patent Applications for Subject Matter Eligibility", state that tangibility is the opposite of "abstract". None of the claimed methods is in any way abstract.

The Examiner respectfully traverses this argument as follows.

In independent claims 45 and 50, each and every recited method step is an abstract step that fails to produce a useful, concrete, and tangible result. Applicants' arguments have been fully considered but have been found unpersuasive.

Applicants' further argue that:

Regarding 101 rejections, applicant responded that the Examiner's rejection by pointing out that a claim that is broad is not non-statutory. Broad claims are supposed to be rejected based on 102 or 103 and not 101. Applicant respectfully additionally points out that the 101 rejections are meant to address cases in which an applicant is attempting to monopolize a method which currently has no utility in hope that at a later stage someone else will find a utility and the applicant will reap the revenue. This is not the case in the current application.

The Examiner respectfully traverses this argument as follows.

The Examiner's remarks illustrated the breadth of Applicants' claims, which clearly encompass nonstatutory subject matter for the reasons set forth above. Applicants' arguments have been fully considered but have been found unpersuasive.

Claims rejected but not specifically mentioned stand rejected by virtue of their dependence. To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. § 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The previous rejections under 35 U.S.C. § 112 that are not set forth below have been withdrawn.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 23-26, 30-31, 75-76, and 79-81 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 23 recites “providing a plurality of computerized design tools, each of which tools stores information restricted to viewing by a respective limited group of workers, assigned to a different system of the vehicle” which is not described in the application as filed. Applicants allegedly find support for this claim limitation on “page 8, lines 7-20 together with page 9, lines 14-16”. The Examiner has reviewed these and other portions of the specification, but has not discovered support for the claim language “each of which tools stores information restricted to viewing by a respective limited group of workers.”

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 23-26, 30-31, 75-76, and 79-81 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites the phrase “each of which tools stores information restricted to viewing by a respective limited group of workers, assigned to a different system of the vehicle”. The intended metes and bounds of this claim limitation are unclear. It is unclear what must be found in the prior art to anticipate this language. The recitation of “information” in this phrase appears to be unrelated to the phrase “information on elements of the different systems of the vehicle” recited later in the claim.

The meaning of the phrase “assigned to a different system of the vehicle” is unclear. It is unknown if this refers to the “respective limited group of workers,” the “plurality of computerized design tools,” or both. There may be a grammatical error in this phrase.

Inasmuch as Applicants are attempting to claim some of the subject matter found in the specification at page 4, lines 13-16, the Examiner respectfully suggests describing a database that does not store confidential information. Alternatively, the limitation “wherein storing the information in the index comprises storing only information which is authorized for viewing by workers of the company from all the groups of workers,” as currently recited, may sufficiently reflect this feature.

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5. Claims 32-40, 43, and 53-71 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites “the database includes information from each of said design tools, said information including only a subset of said hydraulic design information and said electronic design information” which renders the claim vague and indefinite. This phrase appears to ambiguously limit “said design tools” to merely a “hydraulic design tool” and an “electronic design tool.” Alternatively, this phrase appears to present a broad limitation (“information from each of said design tools”) followed by a narrow limitation (“said information including only a subset of said hydraulic design information and said electronic design information”).

Claim 32 recites the phrase “disciplines of the vehicle” which renders the claim vague and indefinite.

Claim 32 recites “sending an electronic message by the first worker, to a second worker assigned to another system or discipline of the vehicle, based on information found in the search” which renders the scope of the claim vague and indefinite. It is unclear how to determine on what *basis* one worker contacts another worker. Because the claim recites “gathering ... a reference to a worker in charge of the element,” the Examiner respectfully suggests claim language directed to contacting a working in charge of the element as provided by the step of “searching the database”.

Claim 32 recites “searching the database, by a first worker assigned to one system or discipline of the vehicle, for information on one or more of the elements” which renders the

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claim vague and indefinite. The phrase “by a worker” appears to define the invention in terms of who is performing the method. In contrast, if the method were performed by a volunteer, such a performance would apparently be beyond the scope of the invention. This limitation does not define the invention. A method is defined in terms of the steps performed to carry out the invention, not in terms of who performs the method. Please see MPEP 2111-2114.

In response to this rejection, Applicants argue primarily that:

Applicant respectfully submits that the claim is clear. If the Examiner has prior art describing the acts of claim 32 as being performed by a volunteer, the question that rises is of obviousness, not clarity.

The Examiner respectfully traverses this argument as follows.

For the reasons set forth above, if the Examiner has prior art describing the acts of claim 32 as being performed by a volunteer, that is, a person performing work but not receiving compensation, there is no guidance whatsoever in the specification, claims, or prosecution history to clarify whether that prior art would be anticipatory, teaching, or irrelevant to the claimed invention. It is at least unclear how the claimed method would be any different were the “searching” performed by a volunteer, computer, or some other actor, and therefore raises the question of the metes and bounds of the claim scope. Applicants’ allegation that a volunteer performing the method would be an issue of obviousness illustrates that this claim is indefinite.

The Examiner is entirely unaware of any precedent or guidance in the MPEP that suggests that a method may be patentably distinguished from the prior art purely on the basis of the type of person performing the method. Therefore the Examiner is unable to determine the novelty or non-obviousness of a method based upon who is performing the method. It is unclear how to interpret this language as presenting a proper claim limitation.

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6. Claims 45-49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 45 recites "selecting substantially all of the elements of the aircraft that are handled by a plurality of personnel from different departments, to serve as major elements that represent the aircraft" which renders the claim vague and indefinite. The term "substantially" as used in this claim is a relative term that fails to particularly point out and distinctly claim the invention.

In response, Applicants' argue primarily that:

As to the use of the term "substantially all", applicant directs the Examiner to MPEP 2173.05(b)(F).

The Examiner thanks Applicants for once again referring to this section of the MPEP (See Applicants' response, 30 January 2006, page 12; Applicants' response, 3 March 2005, page 11).

MPEP 2173.05(b)(F) states:

The phrases "relatively shallow," "of the order of," "the order of about 5mm," and "substantial portion" were held to be indefinite because the specification lacked some standard for measuring the degree intended and, therefore, properly rejected as indefinite under 35 U.S.C. 112, second paragraph. *Ex parte Oetiker*, 23 USPQ2d 1641 (Bd. Pat. App. & Inter. 1992).

The Examiner has considered MPEP 2173.05 repeatedly and maintains that the rejection of claim 45 under 35 U.S.C. § 112, second paragraph, under the current circumstances, is proper. Applicants' arguments have been fully considered but have been found unpersuasive.

7. Claim 77 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 77 recites “such that the gathered information does not include sufficient information for at least some of said design tasks for which the computerized design tools are adapted” which renders the claim vague and indefinite. It is unknown how to assess the prior art to determine whether it depicts “insufficient information for design tasks.” This language is vague, ambiguous, and precludes a proper analysis of the patentability of the invention.

8. Claims 82-85 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 82 recites “designing the vehicle by workers using the computerized tools” which renders the claim vague and indefinite. This language attempts to define the method in terms of who performs the method, not the steps of the method. This language does not define the method. See the rejection of claim 32 above.

Claim 82 recites “opening the database for viewing by workers of a plurality of departments, assigned to different systems of the vehicle,” and “contemplating, by one of the workers, to change an element of the vehicle,” both of which are rejected for at least the reasons set forth above.

Claim 82 recites “contemplating, by one of the workers, to change an element of the vehicle” which renders the claim vague and indefinite. A method which attempts to patent a purely abstract and intangible mental process is clearly vague and indefinite under 35 U.S.C. § 112, second paragraph.

In response, Applicants’ argue primarily that:

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As to the other rejections, applicant respectfully submits that the claim should be evaluated on its whole and not word by word or statement by statement. While the word contemplating may be broad or relate to a mental act, it is not the only limitation of the claim, and the claim should be evaluated in its entirety.

The Examiner respectfully traverses this argument as follows.

The recited step of “contemplating” is vague and indefinite because it is impossible to search the prior art and determine whether a purely abstract and intangible process of “contemplating” has occurred. Applicants’ argument does not distinctly and specifically point out the supposed error in the Examiner’s action, as per 37 CFR 1.111(b). The Examiner is unaware of support in the MPEP for Applicants’ proposed method of interpreting the claims, especially among MPEP 2111, 2113, and 2114. Applicants’ arguments have been fully considered but have been found unpersuasive.

9. Claim 84 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 84 recites “generating a database not including sufficient information to allow performing all design tasks of the vehicle” which renders the claim vague and indefinite. See the rejection of claim 77 above.

10. Claim 86 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 86 recites “opening the database for viewing by workers of a plurality of departments” which renders the claim vague and indefinite. The phrase “by a worker” appears to

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define the invention in terms of who is performing the method. Please see the rejection of claim 32 above.

Claim 86 recites “searching the database for information on one or more of the major elements, which may be affected by a contemplated change to the designed vehicle” which renders the claim vague and indefinite. It is unclear how to identify a “contemplated change”. This language appears to describe an abstract mental concept. The language “may be affected” renders the claim vague and indefinite. It is unclear how to determine what elements “may be” affected and which may not. Certainly it is conceivable that every element “may be” affected by a contemplated change. The metes and bounds of this limitation are unknown.

Claim 86 recites “contacting a worker in charge of the element based on information found in the search” which renders the claim vague and indefinite. Please see the rejection of claim 32 above.

Claim 86 recites “deciding whether to perform the change following the discussion” which renders the claim vague and indefinite. Forming a decision is the epitome of an abstract and intangible mental process and is clearly vague and indefinite under 35 U.S.C. § 112, second paragraph. This language precludes a proper analysis of the patentability of the invention.

Claims rejected but not specifically mentioned stand rejected by virtue of their dependence.

In general, the claim language is replete with errors, indefinite language, vague concepts, and mental steps. When this type of claim language is found throughout the independent claims,

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it precludes a proper analysis of the prior art because it is unknown what Applicants have invented and are seeking to claim. While vague, indefinite language may be sufficient to teach an abstract idea, this language does not comply with 35 U.S.C. § 112, second paragraph, and does not adequately claim the invention for patenting purposes. 35 U.S.C. § 112 requires that the claim language present a clear and definite boundary of what Applicants seek to patent. Where a “grey area” exists and it is therefore uncertain where the boundary of Applicants’ claimed invention lies, this definition fails to comply with 35 U.S.C. § 112, second paragraph, and will be rejected as unpatentable.

Claim Interpretation

MPEP 2143.03 states:

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were rejected on indefiniteness grounds only; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.). Compare *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious) and *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

The claims in this application are subject to numerous rejections under 35 U.S.C. §§ 101 and 112, shown above. The definite metes and bounds of Applicants’ invention cannot be ascertained. It is improper to rely on speculative assumptions and then base a rejection under 35 U.S.C. § 103 on these assumptions.

The state of the pending claims, except claims 72-74 and 41-42, in this application preclude a proper analysis for novelty and non-obviousness under 35 U.S.C. §§ 102 or 103. In

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the interest of compact prosecution, the Examiner provides a brief description of what appears to be the most relevant prior art. Applicants' are reminded of the requirements of 37 CFR 1.111(c) which states "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made." This requirement applies to **references cited**, not merely to references applied in rejections under 35 U.S.C. §§ 102 or 103.

In response to the claim interpretation above, Applicants' argue primarily that:

The Examiner did not perform a complete examination of the application, although MPEP 2143.03 cited by the Examiner in the office action: "*Ex parte Ionescu* ..." seems to imply he should have.

The Examiner respectfully traverses this argument as follows.

Applicants' attention is respectfully drawn to the quotation of MPEP 2143.03 provided in the previous action and above, and especially to the emphasis placed by the Examiner on the reference to *In re Steele*. The reasons for which the Examiner declined to apply prior art to the claims in the previous Office Action are clearly set forth in that Office Action and above.

US Patent No. 5,812,130 to Van Huben et al. discloses a design control system in a concurrent engineering environment (abstract). The system includes a repository containing data including the names of the pieces, the type of data, the level, the version, the owner, and any results which are deemed quality control records (column 10, lines 53-65). The system provides for both public and private libraries (column 12, lines 18-23). Users may access other users via e-mail (column 18, lines 20-26). The system does not necessarily include all the design

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information (column 25, lines 23-29). The system identifies what parts are affected by a given fix (column 25, lines 50-60).

“Access® 97 Unleashed” by Dwayne Gifford, et al., appears to teach several of the limitations recited in at least claim 45. Gifford discloses assigning entries in a database with a unique code and identifying the entries in a database using the assigned codes (page 94, third paragraph, et seq.).

When pointing out the patentable novelty the claims present in light of the state of the art disclosed by the references cited above, the Examiner respectfully recommends considering the guidelines presented in MPEP 2144-2144.09. Distinctions such as “elimination of a step or element and its function” or “changes in size” are typically unpersuasive.

In response to this summary of the prior art, Applicants’ submit that:

The prior art presented by the Examiner generates a database which collects all the data of the vehicle. While such a database may have its advantages it cannot be efficiently used as a fast communication tool between workers for various reasons, such as size, security, and unnecessary information. In addition, the prior art that includes all information has not shown an appreciation of the importance for a tool that allows substantially every design worker to get an overview of the entire vehicle and avoid inter-system design problems before they occur or solve them early in the design. To the best of applicant’s knowledge, the prior art at the time the present application was filed was directed at having each worker deal only with the system to which he/she is assigned without getting an overall view of the vehicle.

In the telephone conference on June 21, 2006, the Examiner suggested that the claims are mere manipulation of database information. Applicant respectfully submits that this is not the case. The set up defined by the claims is a working environment in which a plurality of workers are provided access to a database or index and is totally different from a private system in which a person on his computer performs some data filtering of a database.

The Examiner responds as follows.

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For the reasons set forth in the previous Office Action, the Examiner does not find Applicants' assessment of the prior art to be reasonable. In particular, the previous Office Action stated:

It is noted that an aircraft may contain millions of rivets, each of which are physical elements. The Examiner does not understand Jolliffe to teach selecting rivets to be stored in the database. Jolliffe therefore stores fewer than 10% of the physical elements in the database.

Applicants' response does not refute this analysis of the prior art. The Examiner maintains this position.

Furthermore, Applicants present claims that require "selecting substantially all of the elements" to store in a database, yet argue that the prior art, which allegedly stores all of the elements, is somehow patently distinct from the claimed invention. This contradiction emphasizes the indefiniteness of the claim language and fails to distinguish the claimed invention from the prior art.

Applicants' arguments have been fully considered but have been found unpersuasive.

Claim Rejections - 35 USC § 102

11. Claims 72-74 and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,646,862 to Jolliffe et al. (Jolliffe).

Regarding claim 72, Jolliffe discloses providing a working environment including a plurality of different departments, assigned to perform design tasks of respective different vehicle systems [FIG. 1, references 18, 20, 22, 24, etc.]; and selecting 0% of the physical elements of each system of the vehicle to serve as major elements of the vehicle.

The remaining claim limitations refer to those "physical elements" that were selected, and are therefore not required by the claim when 0% of the "physical elements" are selected.

Regarding claim 73, the claim further limits a limitation of claim 72 that refers to those “physical elements” that were selected and are therefore not required by the claim when 0% of the “physical elements” are selected.

Regarding claim 74, Jolliffe discloses selecting 0% of the physical elements of the vehicle.

Regarding claims 41-42, these claims further limit certain limitations of claim 72 that refer to those “physical elements” that were selected and are therefore not required by the claim when 0% of the “physical elements” are selected.

The analysis of claims 72-74 and 41-42 in conjunction with the Jolliffe reference will likely be applicable to additional pending claims, in their entirety or in part, once the pending rejections under 35 U.S.C. §§ 101 and 112 are overcome. For the reasons set forth above **and in deference to *In re Steele* as cited above**, the Examiner is unable to apply prior art to those claims at this time.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Proctor whose telephone number is (571) 272-3713. The examiner can normally be reached on 8:30 am-4:30 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached at (571) 272-3753. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR)

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